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Practitioner's Docket No. U 016011-9

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Ernesto DURAN LOPEZ

Application No.: 10/555,659

Filed: December 19, 2006

Group No.: 1625

Examiner: Binta M. Robinson

Confirmation No.: 9676

For: INTERMEDIATE COMPOUND WHICH IS USED FOR THE PREPARATION OF  
PIOGLITAZONE

Mail Stop Petition

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

PETITION TO REVIVE PATENT APPLICATION--  
FAILURE TO PAY ISSUE FEE UNINTENTIONAL (37 C.F.R. Sections 1.137(b) and  
1.316)

1. Applicant petitions for revival of this application.

2. Nature of the Abandonment

[ ] in the communication from the PTO mailed \_\_\_\_, it was noted that this application is  
abandoned for:

[x] failure to pay the issue fee within the 3 month period from the date of the notice  
of allowance required by 37 C.F.R. Section 1.316.

CERTIFICATION UNDER 37 C.F.R. 1.10\*

(Express Mail label number is *mandatory*.)

(Express Mail certification is *optional*.)

I hereby certify that this correspondence and the documents referred to as attached therein are being deposited with the United  
States Postal Service on this date January 9, 2008, in an envelope as "Express Mail Post Office to Addressee", mailing Label

Number EV 927 571 981 US, addressed to the Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

01/10/2008 SSITHIBI 00000034 10555659

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Geraldine Marti

(type or print name of person mailing paper)

Signature of person mailing paper

**WARNING:** Certificate of mailing (first class) or facsimile transmission procedures of 37 C.F.R. 1.8 cannot be used to  
obtain a date of mailing or transmission for this correspondence.

**\*WARNING:** Each paper or fee filed by "Express Mail" *must* have the number of the "Express Mail" mailing label placed  
thereon prior to mailing. 37 C.F.R. 1.10(b).

"Since the filing of correspondence under § 1.10 without the Express Mail mailing label thereon is an  
oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will  
not be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.

☐ failure to pay the balance of the issue fee within 3 months from the date of notification of the deficiency as required by 37 C.F.R. Section 1.317.

☐ the undersigned has reviewed his/her records and noted that the issue fee for this application was not timely paid.

3. Date of Filing of This Petition After Abandonment

*(check all items which apply)*

This petition is being filed:

☒ within 3 months after the applicant was first notified of abandonment

☐ within 1 year of the date of abandonment

*NOTE: Under very limited conditions, a petition to revive for unintentional failure to pay the issue fee may exceed the one year limit when abandonment is due to action or inaction by the applicant and the PTO performs a positive documented Official act which could lead a reasonable individual to conclude that the action or inaction was appropriate. Notice of Aug. 26, 1985 (1059 O.G. 4).*

4. Showing Required When Petition Being Filed Is More Than 3 Months From Notification of Abandonment or More Than 1 Year After Abandonment

*NOTE: The applicant must carry the burden of proof to establish that the "entire" delay, from the due date for the fee and the filing of a grantable petition, was unintentional regardless of the circumstances that originally resulted in the abandonment of the application. M.P.E.P. Section 711.03(c), 8th Edition.*

*(complete the following, if applicable)*

☐ Because this petition is more than 3 months after the date the Office first notified the applicant that the application is abandoned, applicant additionally submits a showing as to how the delay between the date the applicant was first notified that the application is abandoned and the filing of this petition under 37 C.F.R. Section 1.134(b) was unintentional. 62 Fed. Reg. 53,131, 53,159 (Oct. 10, 1997). See M.P.E.P., Section 711.03(c), 8th Edition, 700-185.

☐ Because this petition is more than 1 year after the date of abandonment of the application, applicant additionally submits further information as to when applicant (or applicant's representative) first became aware of the abandonment of the application, and a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant (or applicant's representative). 62 Fed. Reg. 53,131, 53,159 (Oct. 10, 1997). See M.P.E.P., Section 711.03(c), 8th Edition, 700-185.

5. The delay in payment of the issue fee was unintentional. The entire delay from the due date in paying the required issue fees until the filing of this petition was unintentional. 37 C.F.R. Section 1.137(b)(3).

6. Payment of the issue fee (37 C.F.R. Section 1.137(b)(1)):

*NOTE: 35 U.S.C. Section 41(a)(7) authorizes the acceptance of an "unintentionally delayed payment of the fee for issuing each patent." Thus, the statute requires the payment of the issue fee as a condition of reviving an application abandoned or patent lapsed for failure to pay the issue fee. Filing a continuing application without payment of the issue fee or any outstanding balance thereof is not an acceptable reply. A 37 C.F.R. Section 1.137(b)(1) petition for unintentional revival indicates that "[i]n an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof." (emphasis added). See also M.P.E.P. Section 711.03(c), 7th Edition.*

*NOTE: The petition must contain or refer to payment of the issue fee then in effect, if no portion of the issue fee was previously submitted, or any outstanding balance of the issue fee then in effect, if a portion of the issue fee was previously submitted. M.P.E.P. Section 711.03(c), 7th Edition.*

☐ has been filed.

☒ is enclosed.

**Fee \$ 1,020.00**

7. Petition fee (35 U.S.C. Section 41(a)(7) and 37 C.F.R. Section 1.17(m))

*NOTE: The fee for the petition to revive an application unintentionally abandoned is \$1,210. 35 U.S.C. Section 41(a)(7) and 37 C.F.R. Section 1.17(m).*

Application status is:

☒ Small entity \$ 770.00

☒ A statement is enclosed.

☐ A statement has been filed.

☐ Other than small entity \$1,540.00

**Fee \$ 770.00**

8. Payment of total fee:

Total issue and petition fee to be paid **\$ 1,790.00**

☒ Enclosed please find check for **\$ 1,790.00**.  
Charge Account 12-0425 for any additional fee required.

☐ Charge Account \_\_\_\_\_ the sum of \$ \_\_\_\_\_ and for any additional fee required.  
A duplicate of this petition is attached.

9. Terminal Disclaimer

*NOTE: 37 C.F.R. Section 137(c) requires that a petition under 37 C.F.R. Section 1.137(b) be accompanied by a terminal disclaimer (and fee), disclaiming a period equivalent to the period of abandonment, regardless of the period of abandonment, in: (1) a design application; (2) a nonprovisional utility application filed before June 8, 1995; or (3) a nonprovisional plant application filed before June 8, 1995. Any terminal disclaimer pursuant to Section 1.137(c) must also apply to any patent granted on any continuing application that contains a specific reference under 35 U.S.C. Sections 120, 121, or 365(c) to the application for which revival is sought. The provisions of Section 1.137(c) do not apply to lapsed patents.*

A. ☐ This utility/plant application was filed on or after June 8, 1995 and no terminal disclaimer is required.

OR

B. This application is:

☐ a design application

☐ a nonprovisional utility application filed before June 8, 1995

☐ a nonprovisional plant application filed before June 8, 1995

and a terminal disclaimer, and the fee therefor, is attached.

Date: \_\_\_\_\_

\_\_\_\_\_  
Signature of person making statement  
that abandonment was unintentional

\_\_\_\_\_  
(type or print name of person making statement)

\_\_\_\_\_  
Residence of person making statement

\_\_\_\_\_  
SIGNATURE OF PRACTITIONER  
John Richards  
(type or print name of practitioner)

\_\_\_\_\_  
P.O. Address

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